

To establish a prima facie case of obviousness, the burden is on the Examiner, in the first instance, to demonstrate that (1) there is some "suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings" and that (2) the prior art references "teach or suggest all the claim limitations." See MPEP § 2143 under the subheading "ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS." If the Examiner has not demonstrated all the elements of a prima facie case, the Examiner's opinion of obviousness is deficient and the "applicant is entitled to grant of the patent." See *In re Oetiker*, 977 F.2d 1443.

For the reasons to follow, it will be clear that the Action has merely concluded that the references suggest their combination without supplying reasons in support of those conclusions, and importantly, has even misinterpreted the technical content and teachings of the references, including unequivocal facts therein, in support of the conclusions that were made. Because the rejection in the first instance relied on legally faulty interpretations of the references, it cannot be sustained nor, indeed, could the claimed invention be constructed from a combination of the references.

First of all, the Examiner has not provided any evidence of a "suggestion or motivation" in the Office Action for combining the cited references. Instead, the Office Action merely attempts to equate each element of the claimed invention with components of selected references without regard to the teachings of the references as a whole. The only suggestion for the claimed combination comes from the Applicant, and the Office may not rely on the Applicant's teachings to provide the suggestion for combining references. Since the Examiner has not provided reasoning in support for combining the cited references, the rejection is wholly unfounded and should therefore be withdrawn.

Moreover, the Office Action fails to prove that the cited references "teach or suggest all the claim limitations", and has thus failed another requirement for establishing a prima facie case of obviousness. The Examiner utterly misconstrues the primary reference, Zernov, et al. (Zernov) as teaching several basic elements of the claimed invention. In section 2, 2<sup>nd</sup> paragraph of the Office Action, the Examiner asserts that Zernov, et al. discloses a "solid state imager [that] has substantial sensitivity to infrared radiation". However, the lines cited in Zernov, 49-60 of col. 6, say nothing whatsoever about substantially infrared-sensitive *solid state imagers* and, in fact, are completely silent about the sensitivity of imagers at all. The cited lines in Zernov disclose nothing more than "a number of infrared (IR) lights that operate in the

range between 750-900 nanometers” while the Examiner fails to explain how this teaches a “solid state imager [that] has “substantial sensitivity to infrared radiation” as claimed in the present application. Zernov does not make any reference to the use of infrared-sensitive imagers anywhere in its disclosure and, thus, one cannot reasonably assume that Zernov teaches their use. Anyone of ordinary skill in the art understands that there is a clear distinction between a mere light emitter (or light source) and a solid state imager (e.g., a camera).

In addition, there are many reasonably plausible explanations that would occur to those skilled in the art for using infrared lights with standard non-infrared-sensitive imagers as taught by Zernov. For example, one of ordinary skill in the art would know that typical IR lights commonly emanate small amounts of visible red light and that many ordinary cameras are slightly sensitive to IR radiation, explaining Zernov's realization of only a moderate increase in “ambient light” and potential improvement of only a “few feet” in visibility. See Zernov, et al., col. 6, lines 49-60.

As taught by the currently claimed invention, the use of a “substantially” IR sensitive imager with IR lights has a dramatic effect on the image appearance (i.e. false color images would be required. (See applicant's specification, paragraphs beginning on page 5, line 24, and page 6, line 32.) Zernov, et al. does not acknowledge the effects attributed to the use of non-standard, *substantially* IR-sensitive *imagers*. Without acknowledging the enormous effect in the appearance they have to the viewer, it is clearly unreasonable to infer that Zernov, et al. teaches or intended to teach the use of the modified, substantially IR-sensitive imagers claimed in the present invention. The Office Action, therefore, did not properly interpret and apply Zernov, et al. as a primary reference to establish a prima facie case for obviousness in rejecting claims 1 and 15 and, subsequently, any of the dependent claims.

Furthermore, the Office Action misapplies Zernov, et al. and its secondary reference, Caimi, et al. in attempting to establish a prima facie case for obviousness in rejecting various dependent features of the presently claimed invention. The Office Action, in rejecting claim 3, erroneously claims that the Zernov reference discloses an imager “sensitive to infrared radiation in the range of about 700 to about 1400 nm”. As noted previously, the cited lines in Zernov disclose *lighting* that *emanates* IR radiation in the “range of **750 to 900** nanometers”. The Action not only erroneously equates IR-lighting with IR-sensitive imagers but, furthermore, inaccurately states the IR range in Zernov as “of about 700 to about **1400** nm”. Since the Action provides no basis for a

prima facie case of obviousness in connection with its rejection of claim 3, the Office should promptly withdraw the rejection.

The Office Action conveys a similarly flawed analysis (or lack of analysis) when it applies the cited secondary Caimi, et al. reference to reject the element of “a solid state imager having an operating mode wherein said solid state imager has substantial sensitivity to infrared radiation”, as in claims 1 and 15. Caimi, et al. discloses the use of separate “light sources” which emit different wavelengths of radiation. However, Caimi, et al. in no manner discloses a solid state *imager* with more than one operating mode that controls an *imager’s* sensitivity to light. The Office Action claims that “it would have been obvious...to modify the system of Zernov, et al. by using the switching device as taught by Caimi, et al. to operate the camera system with different emitting radiation wavelengths...”. However, the present application claims a “solid state imager having an operating mode wherein said solid state *imager* has substantial *sensitivity* to infrared radiation”, not merely a “camera system with different *emitting* radiation wavelengths.” Because the Office Action improperly misconstrues the elements of the presently claimed invention and erroneously compares them to non-analogous elements of Caimi, et al. the current rejections under 35 USC 103 do not support a prima facie case of obviousness, and should therefore be withdrawn.

The Office Action, in rejecting claim 8, does not provide a proper analysis for establishing a prima facie case for obviousness. The Office Action fails to set forth any “suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the [Zernov] reference” in order to make the claimed invention. On page 4, final paragraph of the Office Action, the Action proposes that merely because Zernov expresses that “another object of the invention is to provide a video system that can accommodate multiple cameras to provide forward and reverse viewing and/or an expanded field of view” that the claimed elements of a “rotating means for rotating the solid state imager relative to the hull of said watercraft, said system further comprising indicator means for providing a visual indication of the direction in which the solid state imager is pointing” is deemed obvious under 35 USC 103. The Action seemingly relies on the erroneous notion that merely proposing a particular goal automatically teaches or suggests all potential solutions to the stated goal. The Action utterly fails in its burden of showing how “a video system that can accommodate multiple cameras” teaches or suggests to one of ordinary skill in the art to combine Zernov with general knowledge or other references

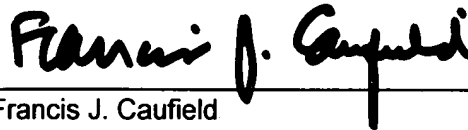
to arrive at the elements of claim 8. For this reason, and the others set forth above, the rejection of claim 8 should be withdrawn.

The rejections of claims 10 and 11 on page 5 of the Action (under headings f and h) are also not supported by the necessary analysis for establishing a prima facie case of obviousness. Obviousness as merely “a matter of designer’s choice” is not in accordance with the requirements under the MPEP or any other precedent for establishing a prima facie case. See MPEP 2143 under the heading “ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS.” Indeed, any invention, obvious or not, could be described as “a matter of designer’s choice”. Furthermore, the fact that the “location of displaying device could be mounted anywhere” provides no basis for establishing why “anywhere”, including “said outboard motor”, is taught or suggested by the relied-upon references for locating or mounting the display device. With regard to the rejection of claim 11 under heading “g:”, the Action provides nothing more than a conclusory statement that “it is obvious to replace a motor of Zernov, et al. (fig. 16) with a trolling motor to easily control the device manually.” Not only does the Action here fail to provide the necessary elements of a prima facie case for obviousness, but Zernov, et al. does not disclose a motor within its specification, claims, or drawings that has any connection to the mounting or manual control of any video observation system, much less the presently claimed invention. Because there aren’t any valid reasons, if any reasons, presented in the Action for rejecting claims 10 and 11, these rejections should clearly be withdrawn.

In view of the discussion above, it is believed that none of the references of record taken either singly or in combination teach or suggest the present invention as claimed. Accordingly, Applicant respectfully requests that a timely Notice of Allowance be issued in this application.

Respectfully submitted,

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Date

  
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